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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALASTAIR J. ANGWIN, FRANK ROBERTSON DAWSON JR.,
and SANDEEP K. SINGHAL

Appeal 2007-3409
Application 09/816,005
Technology Center 2100

Decided: March 13, 2008

Before: HOWARD B. BLANKENSHIP, JEAN R. HOMERE, and
JAY P. LUCAS, *Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal from a final rejection of claims 1, 2, 4 to 11, 13 to 19, and 21 to 24 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to method, apparatus and computer program for providing personal information, in the form of an electronic business card or calendar entry, to a second person. In the words of the Appellants:

The present invention provides a mechanism for building scripted vCard and vCalendar objects based on the accessing user or the environment in which they are accessed. A vCard or vCalendar object may generate a text-based vCard or vCalendar based on credentials. A vcard or vCalendar may be implemented as a Java server page (JSP) template, wherein the basic structure of the vCard or vCalendar is contained in the template, with appropriate invocations of Java methods to fill fields as appropriate. Alternatively, the vCard or vCalendar may be in standard text form, with fields replaced with JavaScript close. The holder of the vCard may then dynamically generate the vCard or vCalendar fields by invoking the scripts corresponding to the fields of interest, within the context of an execution environment that contains the credentials.

(Specification, page 4)

Claims 1, 4, 5 and 6 are exemplary:

1. A method for providing personal data to a recipient, comprising:

providing a personal data object, wherein the personal data object includes personal data and a template with embedded program code for generating a personal data output;

receiving, from the recipient, at least one credential for the recipient;

activating the embedded program code in the template to dynamically generate a personal data output based on the at least one credential; and

delivering the personal data output to the recipient.

4. The method of claim 1 wherein the personal data object comprises at least one of a signed Java class, a Java server page, and a text file with fields replaced by JavaScript code.

5. The method of claim 1, wherein the personal data output comprises one of an electronic business card and an electronic calendar.

6. The method of claim 1, wherein the step of delivering the personal data output to the recipient comprises attaching the personal data output to an e-mail message.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Douvikas

US 6,633,311 B1

Oct. 14, 2003

Rejection:

Claims 1, 2, 4 to 11, 13 to 19 and 21 to 24 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Douvikas.

Groups of Claims:

Group I: Claim 1 is representative of claims 1, 2, 7 to 11, 16 to 19, 22, and 24¹.

¹ Claims 22 and 24 will be considered as part of the first group on the basis of their respective dependencies, despite their omission from the listing in the Brief. (Br. p. 10, top).

Group II: Claim 4 is representative of claims 4, 13 and 21.

Group III: Claim 5 is representative of claims 5, 14, and 23.

Group IV: Claim 6 is representative of claims 6 and 15.

Appellants contend that the claimed subject matter is not anticipated by Douvikas for failure of that reference to teach claimed elements. The Examiner contends that each of the four groups of claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Brief and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).²

We affirm-in-part the rejections.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 102(e). The issue turns on whether Douvikas teaches each of the claimed elements.

² Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

PRINCIPLES OF LAW

Both anticipation under 35 U.S.C. § 102 and obviousness under § 103 are two-step inquiries, in which the first step is a proper construction of the claims and the second step requires a comparison of the properly construed claim to the prior art. *Medichem S.A. v. Rolabo S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003).

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. See *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

"[T]he words of a claim are generally given their ordinary and customary meaning." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, 415 F.3d at 1313 (Fed. Cir. 2005) (en banc).

TiVo, Inc. v. EchoStar Communications Corp. (--- F.3d ---, 2008 WL 249155 at 14, (C.A.Fed. (Tex.)): "We discern no error in the district court's claim construction. While the patent specification includes an embodiment showing the use of 'a C++ class hierarchy derivation of the program logic,' '389 patent, col. 8, ll. 9-10, and uses terms characteristic of object-oriented programming in connection with that example, neither the written description nor the claims anywhere state or imply that the invention must

use object-oriented programming in general, or C++ in particular. Without more, the use of an example that employs object-oriented programming is not sufficient to require that the claims be limited to embodiments using C++ or a similar programming language.”

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a prima facie case for the rejection of Appellants’ claims under 35 U.S.C. § 102 (e). A key part of this analysis is the interpretation of the term personal data object. We note the *Tivo* case (cited above) to guide us to interpret the term as not requiring special object oriented programming, but rather the term can be granted a broad but reasonable interpretation as an object *per se*, consistent with the limitations of the claim.

Group I: Claim 1 for claims 1, 2, 7 to 11, 16 to 19, 22, and 24.

Appellants present three main arguments alleging error in the rejection of the claims of Group I. The first argument contends that Douvikas fails to teach “a personal data object that includes a template with embedded program code for generating a personal data output.” (Br., p. 11, middle).

Reviewing the claim in relevant part, we read:

providing a personal data object, wherein the personal data object includes personal data and a template with embedded program code for generating a personal data output.

Appellants contend that Douvikas fails to disclose such a construction. Examiner points to, *inter alia*, column 13, lines 13 to 21. At that point in the patent, the Java enabled Boomerang application generates template files, loaded with data extracted from the database, through a parsing and tag replacement process. See column 12, line 7, where it is disclosed that the template engine is implemented in Java and reads tagged files. We thus find the claimed templates in Douvikas.

Appellants further contend that Douvikas does not teach “receiving, from a recipient, at least one credential for the recipient”. (Br., p. 15, middle). From Douvikas, column 9, line 9, we see that the key to passing to a recipient to allow him to access your Electronic Business Card (EBC) is the Card ID that you establish, which is under password protection in the EBC system. When you wish to pass your EBC to another, for example “Hans”, Col. 10, line 4, you pass him your Card ID. Hans contacts the EBC center and uses that Card ID to get your information, thus that becomes the credential to activate the generation of the personal data output. (Col. 10, ll. 9-58) We find that the Examiner has demonstrated this feature of the claim to be disclosed in the reference.

Appellants further contend that there is no activation of the embedded code in the template. (Br. p. 16, middle). We support the Examiner’s reasoning on this issue, mainly in view of the disclosures in columns 12 and 13 listed on the previous page of this opinion.

Group II: Claim 4 for claims 4, 13 and 21.

Appellants argue that “Douvikas does not teach or suggest that the personal data object comprises at least one of a signed Java class, a Java server page and a text file with fields replaced by JavaScript code.” (Br., p. 18). The Examiner points out the use of Java based servelets. (Ans., p. 9). We supplement this reasoning with the observation that the claimed personal data object includes both personal data and a template with embedded program code. (Claim 1). In Douvikas, column 12 top, we note that JDBC Objects and Classes implement the database functionality, and Java implementations process the template functionality. We thus concur with the Examiner that this limitation is disclosed by Douvikas.

Group III: Claim 5 for claims 5, 14, and 23.

Appellants argue that no electronic calendar is disclosed in Douvikas. Certainly this argument is an error, as clearly no calendar is required in these claims when an EBC is disclosed. The limitation is met when one of an EBC or a calendar is presented, as argued by the Examiner. (Ans., p. 10).

Group IV: Claim 6 for claims 6 and 15.

We do not find in Douvikas support for the rejection of this group of claims. The personal data output is not conveyed to the recipient in an e-mail in Douvikas.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claims 6 and 15. The rejection of those claims is reversed. The rejection of all the other claims is affirmed.

OTHER ISSUES

REJECTION OF CLAIMS 19 AND 21 TO 23 UNDER 37 C.F.R. § 41.50(B)

We make the following new grounds of rejection using our authority under 37 C.F.R. § 41.50(b).

Rejections:

Claims 19 and 21 to 23 are rejected under 35 U.S.C. § 101 for being drawn to non-statutory subject matter.

Claims 19 and 21 to 23 recite a computer readable medium encoded with a computer program. In the Specification, page 22, line 7 *ff* the Appellants define computer readable medium as including a data signal embodied in a carrier frequency wave.

Such a claim for computer instructions embodied in a signal only is not considered by this office to be statutory under 35 U.S.C. § 101.³ This policy has recently been confirmed by the Court of Appeals for the Federal Circuit in *In re Nuijten*. “A transitory, propagating signal like Nuijten's is not a “process, machine, manufacture, or composition of matter.” Those four categories define the explicit scope and reach of subject matter

³ See, e.g., *In re Nuijten*, 500 F.3d 1346, 1359 (Fed. Cir. 2007). *Ex Parte Hartmann*, No. 2006-1607, 2006 WL 2700810, at 4 (B.P.A.I. 2006) (non-precedential). Signals are not statutory subject matter. See also “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility,” 1300 Off. Gaz. Pat. Office 142, Annex IV(c) (Nov. 22, 2005).

patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter.” *In re Nuijten*, 500 F.3d 1346, 1359 (Fed. Cir. 2007).

DECISION

The Examiner's rejection of claims 6 and 15 is Reversed. The rejection of claims 1, 2, 4, 5, 7 to 11, 13, 14, 16 to 19, and 21 to 24 is Affirmed.

Moreover, we have entered a new grounds of rejection under 37 C.F.R. § 41.50(b) for claims 19 and 21 to 23 as failing to recite statutory subject matter under 35 U.S.C. § 101.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2007). 37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection . . . shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED IN PART

37 C.F.R. § 41.50(b)

pgc

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